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By: Judith Muzyk Date: June 22, 2004
Judith Muzyk

File No. 385/9-1487

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William T. Evans, et al Conf. No. 1047
Serial No.: 10/045,618 Group Art Unit: 3676
Filed : October 23, 2001 Examiner: Christopher J. Boswell
For : SYSTEM AND METHOD FOR AUTOMATED
SELECTION AND DELIVERY OF GIFTS

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RESPONSE TO OFFICE ACTION

Sir:

In response to the Office Action dated January 22, 2004, the applicant respectfully transverses the examiner's grounds for rejection.

The examiner rejected claims 1, 2 and 4-12 as being unpatentable for obviousness over www.greatclubs.com in view of the www.gnc.com.

To establish a prima facie case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2D (BNA) 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1445 (Fed. Cir. 1992). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18

U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Contrary to the examiner's contention, the Great Clubs website does not disclose the invention substantially as claimed. The applicant's invention is directed to the automated delivery of a group of health care products. Both claim 1 and claim 4 provide for the sender to select a subset of healthcare products to be sent as the gift. As an initial matter, such products were not previously given as gifts, being sold to a user individually for consumption by a user. The large variety of possible products and combinations had made it difficult for a sender to select suitable health care products for transmission as a gift, and would additionally have required the user to package the products themselves, to give as a gift. These applicants' subsets of health care products allow a sender to easily select an appropriate group of products directed to a particular, personal need or desire, such as cardiovascular care, which is quite specific to the needs of a recipient, and to have this sent to the recipient packaged as a gift, and provides for resending the selection to the recipient on a programmed basis. This is nothing like the Great Clubs system.

Each of the products available from Great Clubs are conventional gifts - beer, wine, flowers, cigars, coffee, pizza and chocolate. Further, Great Clubs is directed to delivering different products each month, (see page 1-2) on a specific schedule. (See P. 1-2; See also P. 7, Paragraph 2 for examples of "beer I may receive"). The clubs are based on time membership. Once you join, you receive that month's selection of the products, with no input from the sender or receiver on the choice of product delivered. The user cannot select a subset of products, nor assure resending of the same selection.

Further, there is still no teaching or motivation to combine the gnc.com web site with the great clubs website. The GNC website sells products for individual consumption. A search of all the pages listed with the citation by the examiner found no teaching or suggestion for sending these products as gifts, or for providing gifts in defined subsets to simplify the selection process for the user. The cited pages do not even show any grouping of items together, other than as "buy 2 get one free" offers, totally unrelated to the inventive system.

Many products available on the internet for purchase by individual consumers, and to simply pick gnc.com and combine it with the Great Clubs site, which has nothing suggesting delivery of health care care products as gifts, is an improper hindsight reconstruction.

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2D (BNA) 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999), limited on other grounds by In re Gartside, 203 F.3d 1305, 53 U.S.P.Q.2D (BNA) 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher). McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351 (Fed. Cir., 2001)

Here, the examiner has offered speculation, not facts to support the rejection, apparently believing this to be a "simple" invention. It is anything but simple. Offering health care products using the Great Clubs system would defeat the purpose of allowing a sender to personally select a subset of products for delivery, and allow resending of those products to assist the recipient in promoting long term health. It would defeat a purpose of the invention, to give someone health care products directed to their specific personal needs, such as cardiovascular

products, and then send them different health care products every month thereafter.

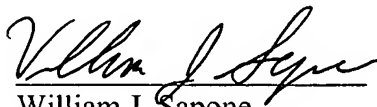
It should also be recognized that the combination actually teaches away from the invention. The Great Clubs site sends conventional types of gifts, food, candy, flowers, etc., and it is the variety or change of products on a monthly basis which is at the heart of the system. It would be contrary to that teaching to instead change over to a personalized gift selection system, and one not based on time membership. Also, the GNC site has nothing to assist a purchaser in selecting and sending any gifts, and that lack is itself an indication of unobviousness.

Given the distinction in the products, significant sender and recipient input into the selection of gifts, and product based rather than time based resending of gifts, that is the automatic "resending" of the gifts, not sending of a different gift, are sufficient to distinguish the applicants' invention from the cited art.

Based upon the above amendments and remarks, favorable consideration and allowance of the application is respectfully requested. However, should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of this application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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